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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,337	08/08/2001	Shell S. Simpson	10007652-1	1943

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DIVECHA, KAMAL B

ART UNIT PAPER NUMBER

2151

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,337

Applicant(s)

SIMPSON ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Claims 1-23 are pending in this application.

Claim Rejections - 35 USC § 112

The 35 USC 112, first and second paragraph rejection presented in the prior final office action has been withdrawn.

Applicant's arguments filed April 06, 2006 have been fully considered but they are not persuasive.

Applicant in response filed argues in substance that:

a. “Li does not disclose or suggest obtaining a style sheet defining a conversion of the received content to a converted content, determining a desired format for a desired destination for the content, and then selecting an imaging conversion program from a plurality of imaging conversion program based on the style sheet and the desired format. Li makes no mention of selecting a particular template based on both a style sheet and a desired format for a desired location to which the converted content is ultimately transmitted” (remarks, page 9).

Applicant argument as in [a] above is not persuasive in light of the following:

Applicant specification states:

“...note again that the style sheet is optional; the URL parameters could contain information about how data...” (pg. 63-64 [0182])

“...note that block 1340 is an optional step. The content could simply be put into a default format...” (pg. 65 [0185])

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First, applicant specification suggests that the “...style sheet is optional...” (see page 63-64 [0182]).

Secondly, applicant specification suggests that the step of block 1340 of figure 13, which is the process of determining the desired format of the consuming service, is an optional step.

That is, the specification simply fails to teach the process of selecting a particular imaging conversion programs based on both a style sheet and a desired format for a desired location to which the converted content is ultimately transmitted” and is certainly not a requirement of the claimed invention and the claims (see the 35 U. S. C. 112, first paragraph rejection).

The subject matter as argued by the applicant is simply interpreted in light of applicant’s specification that suggests, “...the method would then move to block 1350, wherein it would be determined, based on the style sheet, and/or the desired format information from block 1340, or via another convenient method...” (see applicant’s specification, page 65 [0185]).

There is simply no suggestion in the applicant’s specification that the method comprises selecting an imaging conversion program from a plurality of imaging conversion programs based on both the style sheet and the desired format.

Furthermore, applicant simply fails to define the imaging conversion program and/or differentiate between the style sheets and the imaging conversion program. Therefore, the templates as in Li can reasonably be interpreted as the conversion program since the template enables the process of converting the content based on the style sheet because Li’s templates, i.e. imaging conversion program includes style sheets.

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Therefore, based on the above interpretation and applicant's specification, Li expressly discloses the process of obtaining a style sheet defining a conversion of the received content to a converted content, determining a desired format for a desired destination for the content, and then selecting an imaging conversion program from a plurality of imaging conversion program based on the style sheet and/or the desired format (see the action below).

DETAILED ACTION

Specification

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claims.

The claims recite, "determining a desired format for a desired destination for the content; and selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format", however specification merely describes the

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process of selecting an imaging conversion program to process the content (fig. 13 item #1350, see page 62-65).

Hence, the above claim limitation presents the subject matter that that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in objection to specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 1-4, 6-12, and 17-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Li (Pub. No.: US 2004/0205613).

As per claim 1, Li discloses a method for providing imaging conversion services on content, comprising the steps of: receiving content comprising non-image data (par. 41, lines 2-4); obtaining a style sheet defining a conversion of the received content to a converted content (par. 41, lines 4-7; par. 22, line 1); determining a desired format for a desired destination for the content (pg. 7 [0059], pg. 8 [0068]); selecting an imaging conversion program from a plurality of imaging conversion programs based on a the style sheet and the desired format (par. 52, lines 24-27; pg. 2 [0016], [0018], [0022], pg. 3 [0033], [0038], pg. 4 [0040]-[0041], pg. 5 [0049], pg. 7 [0059] and pg. 2 [0015-0024]); converting the content using the selected imaging conversion program and the style sheet to obtain the converted content (par. 41, lines 10-11); and transmitting the converted content to a desired destination (par. 42, lines 1-3).

As per claim 2, Li discloses the process wherein the acts of receiving, obtaining, selecting, converting and transmitting are performed by a web service at a web site identified by a URL reference (par. 54, lines 1-4 and fig. 2).

As per claim 3, Li discloses that the content is obtained from a source web site that is different from the web service web site (par. 18, lines 3-4); and wherein the obtaining a style sheet step comprises receiving a style sheet from the source web site (par. 18, lines 3-6).

As per claim 4, Li discloses that the content is obtained from a source web site that is different from the web service web site (par. 18, lines 3-4); and wherein the obtaining a style sheet step comprises selecting a default style sheet (par. 41, lines 5-6).

As per claim 6, Li discloses that the criterion for the selecting a conversion program step selects a conversion program dynamically based on a negotiation taking place between the web service and a requestor and based on capabilities of each (par. 52, lines 24-27; par. 15, lines 1-3; and par. 16, lines 3-4).

As per claim 7, Li discloses that the transmitting step comprises the step of transmitting the converted content to a consuming web site or service (par. 45, lines 19-21).

As per claim 8, Li discloses that the transmitting step comprises transmitting the converted content to storage in a personal imaging repository (par. 42, lines 1-3).

As per claim 9, Li discloses that the transmitting step comprises transmitting a reference to the converted content, with the reference referring to the converted content (par. 41, lines 12-13).

As per claim 10, Li discloses that the selecting an imaging conversion step comprises associating a reference for the selected imaging conversion program to the content or to a reference for the content and making that content or the content reference accessible to a user, to thereby permit the converting step to be performed on a demand basis (par. 18, lines 3-6; par. 16, lines 3-4; and par. 24, lines 3-5).

As per claim 11, Li discloses that the receiving content step comprises receiving a reference to the content and associating the content reference to a reference for the web service method and making this content reference accessible to a user, so that the conversion services may be performed on a demand basis (par. 18, lines 3-6; par. 16, lines 3-4; and par. 24, lines 3-5).

As per claim 12, Li discloses that the converted content is stored on the web service (par. 52, lines 34-37).

As per claim 17, Li discloses that said obtaining a style sheet step comprises allowing a user to configure a style sheet for use with the method (par. 24, lines 6-7).

As per claim 18, Li discloses that the transmitting step comprises transmitting the content to another service (par. 45, lines 19-21).

As per claim 19, Li discloses a system for providing imaging conversion services on content, comprising: a component for receiving content comprising non-image data (par. 41, lines 2-4); a component for obtaining a style sheet defining a conversion of the received content to a converted content (par. 41, lines 4-7; par. 22, line 1); a component for determining a desired format for a desired destination for the content (pg. 7 [0059], pg. 8 [0068]); component for selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format (par. 52, lines 24-27; pg. 2 [0016], [0018], [0022], pg. 3 [0033], [0038], pg. 4 [0040]-[0041], pg. 5 [0049], pg. 7 [0059] and pg. 2 [0015-0024]); a component for converting the content using the selected imaging conversion program and the style sheet to obtain converted content (par. 41, lines 10-11); and a component for transmitting the converted content to a desired location (par. 42, lines 1-3).

As per claim 20, Li discloses a program product on a computer readable medium for implementing a method when executed on a computing system, the program product comprising: code for providing imaging conversion services on content (par. 52, lines 24-27); code for receiving content comprising non-image data (par. 41, lines 2-4); code for obtaining a style sheet defining a conversion of the received content to a converted content (par. 41, lines 4-7; par. 22, line 1); code for determining a desired format for a desired destination for the content (pg. 7 [0059], pg. 8 [0068]); code for selecting an imaging conversion program from a plurality of imaging conversion programs based on a the style

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sheet and the desired format (par. 52, lines 24-27, pg. 7 [0059] and pg. 2 [0015-0024]); code for converting the received content using the selected imaging conversion program and the style sheet to obtain the converted content (par. 41, lines 10-11); and code for transmitting the converted content to a desired location (par. 42, lines 1-3).

As per claim 21, Li discloses that the converted content comprises an image (par. 34, line 3).

As per claim 22, Li discloses that the converted content comprises an image (par. 34, line 3):

As per claim 23, Li discloses that the converted content comprises an image (par. 34, line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li (Pub. No.: US 2004/0205613) in view of Todaka (U. S. Patent No. 6,785,022).

As per claim 5, Li does not disclose the process wherein the desired destination is a printer having a parameter and wherein the desired format for the printer is related to that parameter.

Todaka, from the same field of endeavor discloses the process of converting a document to make it compatible with a printer (i.e. it converts the document in order to enable the printer to print the document, col. 4, lines 25-26).

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Therefore it would have been obvious to person of ordinary skilled in the art at the time the invention was made to modify Li in view of Todaka in order to print the document in a printer compatible format.

One of ordinary skilled in the art would have been motivated because it would have enabled the process of converting documents in order to make them compatible with a printer, as taught by Todaka.

4. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (Pub. No.: US 2004/0205613) in view of Houser ("Using Style Sheets to Publish XML to the Web").

As per claim 13, Li does not disclose the process of filtering the content to delete selected items therein.

Houser, from the same field of endeavor, explicitly discloses the process of filtering the content to delete the selected content by using style sheets (pg. 4 L31).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to filter the content to delete selected items.

One of ordinary skilled in the art would have been motivated because these capabilities would have provided a powerful mechanism, not only for customizing the publishing of documents, but for transforming documents that can be displayed by any web browser (Houser, pg. 4).

As per claim 14, Li does not disclose the process of labeling different items in the content. Houser discloses the process of labeling different items in the content (pg. 4 L30). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to label different items in the

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content. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 13 above.

As per claim 15, Li does not disclose the process of reordering labeled content. Houser explicitly discloses the process of reordering labeled content (pg. 4 L35). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to reorder labeled content. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 13 above.

As per claim 16, Li does not disclose the process of changing a layout of the content on a page. Houser explicitly discloses the process of changing a layout of the content on a page (pg. 4 L35). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Houser as stated above with Li in order to change a layout of the content on a page. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 13 above.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Yach, Pub. No.: US 2002/0112078 A1.
- b. Akimoto, U. S. Patent No. 6,775,711 B1.
- c. Kirkeby, U. S. Patent No. 6,721,803 B1.
- d. Camut et al., U. S. Patent No. 6,684,257 B1.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

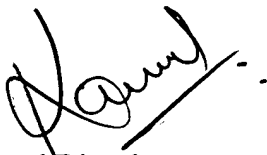
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

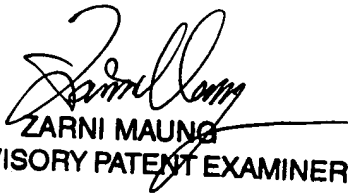
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kamal Divecha
Art Unit 2151
May 22, 2006.



ZARNI MAUNG
SUPERVISORY PATENT EXAMINER